

## **REMARKS**

### **I. Summary of Amendment**

Applicant has amended claims 95-97. Accordingly, claims 1-85 and 92-97 are pending in this application. The amendments to the claims are fully supported by the application as originally filed, and no new matter is introduced by this response.

### **II. Summary of Office Action**

In the Office Action<sup>1</sup>, the Office:

- (a) rejected claims 95-97 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter;
- (b) rejected claims 1-5, 7-18, and 20-26 under 35 U.S.C. § 103(a) over U.S. Pat. Appl. Pub. No. 2002/0035486 A1 ("*Huyn*") in view of U.S. Pat. Appl. Pub. No. 2002/0082738 A1 ("*Goldman*");
- (c) rejected claims 19, 27-35, and 62-67 under 35 U.S.C. § 103(a) over *Huyn* in view of U.S. Pat. Appl. Pub. No. 2002/0022973 A1 ("*Sun*"); and
- (d) rejected claims 6, 36-61, and 68-97 under 35 U.S.C. § 103(a) over *Huyn* in view of *Goldman*, and further in view of U.S. Pat. Appl. Pub. No. 2005/0130321 A1 ("*Nicholson*").

### **III. Rejection under 35 U.S.C. § 101**

The Office rejected claims 95-97 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. Applicant has amended each of claims 95-97 to recite a "non-transitory, computer-readable storage medium." Therefore, amended claims 95-97 are directed to statutory subject matter. Accordingly, the rejection of claims 95-97 under 35 U.S.C. § 101 should be withdrawn.

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<sup>1</sup> Applicant notes that the Office Action contains numerous statements concerning the related art, claims, etc. Regardless of whether any such statement is addressed specifically herein, Applicant declines to automatically subscribe to any assertion or characterization in the Office Action.

#### **IV. Rejections under 35 U.S.C. § 103(a)**

The Office rejected claims 1-5, 7-18, and 20-26 under 35 U.S.C. § 103(a) over *Huyn* in view of *Goldman*.

The rejection of independent claim 1 should be withdrawn because there is no prima facie case of obviousness. Independent claim 1 recites, among other things, "selecting, via [a] computer system, a second question according to the first information and according to a diagnostic algorithm generated using at least one of a multivariate analysis and a tree segmentation technique." The Office admitted that *Huyn* "does not explicitly teach . . . a multivariate analysis and a tree segmentation technique." Office Action at 5.

The Office asserted, however, that *Goldman* purportedly "teaches a multivariate analysis and a tree segmentation technique." Office Action at 5. Even assuming that this were to be true, which Applicant does not concede, the Office provided no explanation as to how there would be any combination of the alleged multivariate analysis and the alleged tree segmentation technique of *Goldman* with the disclosure of *Huyn* to generate a diagnostic algorithm that could be used to select a question. Instead, the Office merely pointed to paragraph [0005] and claim 5 of *Goldman*, and asserted that "[i]t would have been obvious to one of ordinary skill in the medical art to combine computer-implemented questionnaire system as taught in *Huyn* with the different analysis techniques as taught in *Goldman*," and that "[t]he combination would lead to different analysis techniques that generate secondary questions based on the responses of the first question." Office Action at 5. Applicant respectfully disagrees.

Paragraph [0005] of *Goldman* discloses "a multivariate analysis of components of an ongoing semiconductor process for real time in-situ control," and claim 5 of

*Goldman* refers to "a method for controlling a product quality during product manufacturing . . . wherein [a] quantitative empirical modeller includes statistical techniques selected from the group consisting of linear regression nearest neighbor, clustering, process output empirical modelling (POEM), classification and regression tree (CART), semi-square automatic interaction detector (CHAID), decision trees and neural network empirical modelling." Such disclosures bear no relation to the generation of a diagnostic algorithm that could be used to select a question. Therefore, *Goldman*, whether alone or in combination with *Huyn*, fails to disclose or suggest at least "selecting, via [a] computer system, a second question according to the first information and according to a diagnostic algorithm generated using at least one of a multivariate analysis and a tree segmentation technique," as recited by independent claim 1.

Moreover, there would have been no legitimate reason for one of ordinary skill in the art to consider modifying *Huyn* to incorporate any of the features of *Goldman* without the hindsight benefit of the teachings in Applicant's disclosure. For example *Huyn* and *Goldman* are directed to completely different fields of endeavor. On the one hand, *Huyn* concerns a clinical questionnaire that presents medical questions. *Goldman*, on the other hand, relates to a method of enhancing yield in multi-process manufacturing, such as manufacturing in the semiconductor industry. One of ordinary skill in the art would not have had any legitimate reason to combine *Huyn*'s disclosure relating to a clinical questionnaire with *Goldman*'s disclosure relating to multi-process manufacturing of items such as semiconductor components.

For at least these reasons, the rejection of independent claim 1 under 35 U.S.C.

§ 103(a) over *Huyn* in view of *Goldman* should be withdrawn.

The rejection of dependent claims 2-5, 7-18, and 20-26 under 35 U.S.C. § 103(a) should also be withdrawn at least because of their dependence from independent claim 1.

The Office also rejected claims 19, 27-35, and 62-67 under 35 U.S.C. § 103(a) over *Huyn* in view of *Sun*. Claims 19 and 27-35 depend from independent claim 1, and claims 62-67 depend from independent claim 36. The Office admitted that *Huyn* "does not explicitly teach . . . [at least one of] a multivariate analysis and a tree segmentation technique," as recited by independent claims 1 and 36. Office Action at 5. *Sun*, separately or in combination with *Huyn*, fails to cure this deficiency of *Huyn*. Indeed, *Sun* does not appear to mention or otherwise teach a multivariate analysis or a tree segmentation technique. Accordingly, the rejection of dependent claims 19, 27-35, and 62-67 under 35 U.S.C. § 103(a) over *Huyn* in view of *Sun* should be withdrawn at least because of their dependence from independent claims 1 and 36.

The Office also rejected claims 6, 36-61, and 68-97 under 35 U.S.C. § 103(a) over *Huyn* in view of *Goldman*, and further in view of *Nicholson*.

Claim 6 depends from independent claim 1, and nothing in *Nicholson* cures the above-noted deficiencies of *Huyn* and *Goldman*. For example, *Nicholson* does not appear to mention or otherwise teach a multivariate analysis or a tree segmentation technique that would be combined with the disclosure of *Huyn* to generate a diagnostic algorithm that could be used to select a question. Accordingly, the rejection of dependent claim 6 under 35 U.S.C. § 103(a) over *Huyn* in view of *Goldman*, and further

in view of *Nicholson* should be withdrawn at least because of its dependence from independent claim 1.

Claims 41 and 73 depend from independent claims 36 and 68, respectively. As discussed below, the Office has made no prima facie case of obviousness as to independent claims 36 and 68. Accordingly, the rejection of dependent claims 41 and 73 under 35 U.S.C. § 103(a) over *Huyn* in view of *Goldman*, and further in view of *Nicholson* should be withdrawn at least because of their dependence from independent claims 36 and 68.

The Office rejected claims 36-40, 42-61, 68-72, and 74-97, "for similar reasons as given above," asserting that claims 36-40, 42-61, 68-72, and 74-97 purportedly "recite substantially similar limitations as that already discussed in 1-18, 20-26." Office Action at 15. Applicant respectfully disagrees. The rejection of claims 36-40, 42-61, 68-72, and 74-97 should be withdrawn because the Office failed to set forth a prima facie case of obviousness. As is apparent from a review of claims 36-40, 42-61, 68-72, and 74-97, they do not recite "substantially similar limitations" as claims 1-18 and 20-26. Moreover, to the extent that claims 36-40, 42-61, 68-72, and 74-97 are rejected based on *Huyn*, *Goldman*, and/or *Nicholson*, the Office provided no explanation as to the pertinence of *Huyn*, *Goldman*, or *Nicholson* with respect to claims 36-40, 42-61, 68-72, and 74-97. See 37 C.F.R. § 1.104(c)(2). Since no prima facie case of obviousness has been made, the rejection of claims 36-40, 42-61, 68-72, and 74-97 under 35 U.S.C. § 103(a) over *Huyn* in view of *Goldman*, and further in view of *Nicholson* should be withdrawn.

**CONCLUSION**

Applicant requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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